

REMARKS

In reply to the Office Action dated April 7, 2005, Applicant has amended claim 44 to further clarify the claimed invention without narrowing the literal or equivalent scope of protection afforded by these claims and added new claims 61-78 to protect additional aspects of the invention. As a result of this Amendment, claims 1-78 are currently pending.

On page 2 of the Office Action, the Examiner objected to claims 39 and 44 based on several informalities. With respect to claim 39, the Examiner stated that the word "th" be changed to "the." After careful review, however, the word "th" does not appear to be present in the claims. In any event, Applicant has submitted a new listing of claims which replaces all prior versions. This listing of claims does not include the word "th". With regard to dependent claim 44, Applicant has amended claim 44 to depend upon claim 43 to provide appropriate antecedent basis for the term "transparent pane." Accordingly, Applicant respectfully requests that the objection to claims 39 and 44 be withdrawn.

As discussed on pages 2-4 of the Office Action, the Examiner rejected claims 1-5, 9, 12, 13, 37-39, 41 and 43-52 under 35 U.S.C. § 102(b) as being anticipated by Young (U.S. Patent No. 6,058,640). And, as set forth on pages 4-5 of the Office Action, the Examiner rejected claims 6-8, 40, and 53 under 35 U.S.C. § 103(a) as being unpatentable over Young. In addition, the Examiner rejected claims 10, 11 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Young in view of Polzin (U.S. Patent No. 5,025,581), according to the rationale discussed on pages 5-6 of the Office Action. Finally, the Examiner rejected claims 14-26, 27-36, and 54-60 under 35 U.S.C.

§ 103(a) as being unpatentable over Young in view of Geiser et al. (U.S. Design Patent No. 419,303), for the reasons discussed on pages 6-7 of the Office Action.

Young, Polzin, and Geiser, however, fail to render the claimed invention unpatentable. Each of the claims recite different combinations of features that distinguish the invention from the prior art. For example, independent claim 1 recites a combination that includes, among other things:

an advertising information sheet removably disposed within the display sleeve, the advertising information sheet comprising information pertaining to the article of merchandise, the information being visible through the window,

wherein the advertisement arrangement is configured to allow the advertising information sheet to be exchanged for a different advertising information sheet,

(unamended claim 1, ll. 11-16). Independent claim 27 recites a method including, for example:

providing an advertising information sheet within the advertisement holder, the advertising information sheet comprising information pertaining to the article of merchandise,

wherein the advertising information sheet is arranged within the advertisement holder so that the information is visible through the window, and

wherein the advertisement holder is configured to allow the advertising information sheet to be exchanged for a different advertising information sheet,

(unamended claim 27, ll. 7-14). Independent claim 37 recites a further combination that includes, among other things:

an advertising information sheet removably associated with the display sleeve, the advertising information sheet comprising information likely to induce a customer to purchase the article of merchandise, the information on the advertising information sheet being visible through the window,

(unamended claim 37, ll. 8-11). And independent claim 43 recites yet another combination that includes, *inter alia*:

an advertising information sheet removably disposed within the display sleeve, the advertising information sheet comprising information visible through the transparent pane in the window,
wherein the advertisement arrangement is configured to allow the advertising information sheet to be exchanged for a different advertising information sheet.

(unamended claim 43, ll. 12-17). Independent claim 45 recites still another combination that includes, among other things:

“an information sheet removably associated with the display sleeve, the information sheet including information visible through the front side.”

(unamended claim 45, ll. 7-8). New independent claim 73 recites a combination that includes, *inter alia*),

an advertising sheet configured to move between a first sheet position, where the sheet is arranged within the sleeve to display information through the display window of the sleeve and to advertise a first type of article disposed within the sleeve, and a second sheet position, where the sleeve is disposed outside of the sleeve; and
wherein the sleeve is configured to allow the advertising sheet to be exchanged for a different advertising sheet disposed in the sleeve to display different information through the display window of the sleeve and to advertise a second type of article disposed within the sleeve,

(new claim 76, ll. 7-15). Finally, independent method claim 77 recites a combination of that includes, for instance:

inserting a first type of article within the sleeve when the sleeve is in the second sleeve position;
inserting a first type of advertising sheet within the sleeve to display information through the display window of the sleeve and to advertise the first type of article disposed within the sleeve;
removing the first type of article from within the sleeve;
inserting a second type of article within the sleeve when the sleeve is in the second sleeve position;
removing the first type of advertising sheet from within the sleeve;
and

inserting a second type of advertising sheet within the sleeve to display different information through the window of the sleeve and to advertise the second type of article inserted within the sleeve,

(new claim 77, ll. 6-17). At the very least, Young, Polzin, and Geiser fail to disclose or suggest any of these exemplary features recited in the independent claims 1, 27, 37, 43, 45, 73, and 77.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the Young patent. See M.P.E.P. § 2131 (7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. See, e.g., *In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An Examiner’s bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty.).

Moreover, to make out a *prima facie* case of obviousness, the Examiner must demonstrate (1) that Young, as proposed to be modified by the teachings of the Examiner’s own reasoning, or the teachings of Polzin or Geizer et al., disclose or suggest each and every feature recited in the claims, (2) that there is a reasonable probability of success in making such modifications, and (3) the existence of some suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to make such

modification so as to result in the claimed invention. See M.P.E.P. § 2143 (7th ed. 1998). It bears emphasizing that each of these requirements must be found in the prior art — not based on Applicant's own disclosure. See *id.*

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103.

In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Young, taken alone or in combination with any other prior art reference, can either anticipate or render obvious each and every one of the limitations present in the independent claims, as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Young discloses a transparency display apparatus that includes one or more movable panels (20, 66) for creating different display scenes. See, e.g., Abstract; Figs. 4 and 5B. Young, however, fails to provide any disclosure of an advertising sheet that is **removably** disposed or associated within a display sleeve, as more particularly recited in independent claims 1, 37, and 45. Nor does Young provide any disclosure of an advertisement holder that is structured to allow an advertisement sheet to be **exchanged** for a different sheet, as recited in independent claims 27, 43, 73, and 77. In this regard, the Examiner appears to contend that the panel (20) of Young is "removably

disposed" within display device (10). Office Action at 3. Panel (20), however, cannot be removed from the display sleeve (10). As Young explains,

The slidable panel 20 has shoulders 30 and 32 thereon that are formed as truncated cones with the larger end of the cone facing outwardly to provide . . . large end surfaces 34 and 36 that ride against sides 38 and 40 of the frame 39. When the panel is slid outwardly, the shoulders 30 and 32 **stop outward movement of panel 20** when they engage corresponding surfaces 35 and 37 on frame 39.

Col. 5, ll. 17-23 (emphasis added). A skilled artisan would thus readily recognize that the panel (20) of Young cannot constitute the **removable** advertising sheet of independent claims 1, 37, and 45. Nor can the display device (10) of Young constitute an advertisement holder that is structured to allow an advertisement sheet to be **exchanged** for a different sheet, as required by independent claims 27, 43, 73, and 77. These features are neither explicitly stated, nor necessarily present within the Young patent disclosure, as required by 35 U.S.C. § 102. Accordingly, Young cannot anticipate the independent claims.

In the Office Action, the Examiner appears to assert that the term "configured" only covers the mere ability to perform any imagined use of the display device of Young. For instance, the Examiner argues that the

"display sleeve [of Young] is understood to be **configured** to receive a portion of the article of merchandise within the display sleeve because the article of merchandise **can be** inserted/removed where the front and back sides are flexible so as to permit at least a portion of the article of merchandise to be passed into an interior of the display sleeve via the at least one open end of the display sleeve."

Office Action at 4 (emphasis added). In light of this interpretation, the Examiner has afforded little, if any, patentable weight to claim phrases that involve the term "configured." This interpretation, however, is contrary to not only the ordinary and customary meaning of the words used in the claims, but also Federal Circuit

jurisprudence. Rather, the terms "configured" and "capable" involve quite different meanings. For example, the term "capability" is commonly understood to mean "[t]he quality of being capable; ability." THE AMERICAN HERITAGE COLLEGE DICTIONARY 207 (3d ed. 1997). The American Heritage College Dictionary states that "construction of *able* to ascribes to its subject the ability to accomplish the action expressed in its complement." *Id.* at 3. As an illustration of this construction, the Federal Circuit has recognized that a "*programmable* selection means" encompasses a selection means that is *capable of* being programmed to performed a claimed function. See *Intel Corp. v. U.S. Int'l Trade Comm'n*, 946 F.2d 821, 831-32 (Fed. Cir. 1991); see also *Chad Indus. v. Automation Tooling Sys.*, 938 F.Supp. 601, 611-12 (C.D. Cal. 1996) (interpreting the phrase "means for driving said clinching mechanism through a *programmably* determined path of travel").

By contrast, the term "configured" does not include any form of the term "ability." Instead, this term is commonly understood as being synonymous with such structural terms as designed, arranged, set up, shaped, or structured. See, e.g., THE AMERICAN HERITAGE COLLEGE DICTIONARY 292 (3d ed. 1997). In fact, the courts have repeatedly construed the term "configured" in patent claims as covering structural limitations, as opposed to the mere capability of performing a purely functional limitation at some unidentified point in time. For instance, in *Alpha Enterprises v. Tomato Land Display Sys.*, 92 F.Supp.2d 733 (S.D. Ohio 2000), the court construed the phrase "projection means . . . *configured to* engage . . ." as a structural limitation that required more than a mere capability to perform the recited limitations. See *id.* at 737-38. Based on this interpretation, the court found that the defendant's device did not fall within the scope of

the claimed projection means because it could not perform the claimed engaging function. See *id.*; see also *National Presto Indus., Inc.*, 76 F.3d 1185, 1189-90 (Fed. Cir. 1996) (recognizing that "a container . . . *configured* for reception" recited a structural limitation) (emphasis added). Moreover, by way of further illustration, the Federal Circuit in *Best Lock Corp. v. Ico Unican Corp.*, 896 F.Supp. 836 (S.D. Ind. 1995), discussed how an examiner decided to issue a patent based on the determination that the phrase "the blade and keyway . . . *configured* to provide a clearance gap . . ." constituted a structural limitation. See *id.* at 938-41 (emphasis added). With this in mind, Applicant respectfully requests that the Examiner acknowledge that the term "configured," as used in the claims, defines structural limitations that are patentably distinguishable from the teachings of Young.

Moreover, Geiser et al. fails to remedy the deficiencies of Young. For example, the Examiner relies upon Geiser et al. solely to allegedly disclose the existence of "an identification and personalization handle cover including a display sleeve disposed about at least a portion of a handle of luggage," (see Office Action ¶ 6 at 6). As discussed above, the panel (20) of Young cannot constitute the removable advertising sheet of independent claims 1, 37, and 45. And the display device (10) of Young cannot constitute a advertisement holder that is structured to allow an advertisement sheet to be exchanged for a different sheet, as required by independent claims 27, 43, 73, and 77. Geiser et al. does not supply these missing features. As a result, modifying the Young display device with the teachings of Geiser et al. cannot overcome the shortcomings of Young.

Turning to the dependent claims and the Examiner's secondary grounds for rejection, Geiser et al. and Polzin all undeniably fail to overcome the deficiency of Young. For example, the Examiner relies upon Polzin to allegedly teach the existence of a display sleeve that is "formed of at least poster-board paper and cardboard," as recited in dependent claims 11 and 42. See Office Action ¶ 5 at 5. Similarly, the Examiner relies upon Young to allegedly teach the notion of choosing an information sheet that has particular dimensions (e.g., 8 ½ inches by approximately 11 inches). See Office Action ¶ 4 at 5. As such, one having ordinary skill in the art would readily recognize that these grounds for rejection do not provide any suggestion or motivation for the Examiner's proposed modification of Young. Consequently, each of the secondary grounds for rejection fails to remedy the deficiencies of Young.

For at least these reasons, Young, Polzin, and Geiser fail to disclose or render obvious each and every element recited in independent claims 1, 27, 37, 43, 45, 73, and 77. In addition, claims 2-26, 28-36, 38-42, 44, 46-72, 74-76, and 78, which all depend upon one of the independent claims, respectively, recite additional features that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims are allowable for at least the same reasons discussed above with respect to the independent claims.

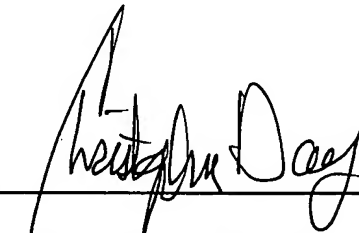
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of all the pending claims 1-78. Should it be necessary to resolve any additional concerns and expedite the issuance of a Notice of Allowance, the Examiner is invited to contact Applicant's representative at (202) 408-6052.

Please grant any extension of time to the extent required to enter this response
and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

**FINNEGAN, HENDERSON, FARABOW,
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